

REMARKS

Claims 1-22, 40-49, 51, 53, and 55-57 were and remain pending. Reconsideration and allowance of these claims in view of the following remarks are respectfully requested.

Applicants appreciate the courtesy that Examiner Nguyen extended via a telephonic interview with Applicants' below-signed representative on November 26, 2007. During the interview, the pending multiplicity rejection was discussed. Applicants requested withdrawal of the multiplicity rejection for the reasons listed below. Examiner Nguyen agreed to withdraw the multiplicity rejection and examine the presently pending 37 claims. Examiner Nguyen asked that Applicants formalize their arguments in the present Response. Applicants provide the requested remarks below.

Claims 1-22, 40-49, 51, 53 and 55-57 were rejected under 35 U.S.C. § 112, second paragraph for undue multiplicity. Applicants respectfully traverse this rejection for the following reasons.

First, the Examiner bases this rejection on Applicants' allegedly excessive inclusion of 13 independent claims. However, the number of independent claims is a direct result of the Examiner's allowance of these claims when in dependent form. Specifically, in a voice message from Examiner Nguyen to the undersigned on May 30, 2007 and also in the April 2, 2007 Office Action, the Examiner indicated that claims 3, 4, 7, 8, 10, 12, 13, 16-22, 40, 41, and 51 would be allowable if rewritten in independent form. *See* 5/30/07 Amendment, p. 18; *see also* 4/2/07 Office Action, Office Action Summary and p. 3. The currently pending 13 independent claims are merely the result of Applicants' conversion of dependent claims 3, 4, 7, 10, 12, 16, 18, 19, and 20 into independent form. Following the Examiner's suggested amendment is not a proper ground for asserting that Applicants "unduly multiplied" the number of independent claims. 37 CFR § 1.55(b).

Applicants' conversion of dependent claims into independent claims based on the Examiner's suggestion to do so is not the type of impermissible multiplicity envisioned by Rule 75(b). The differences between the claims, based on their conversion from dependent to independent status, is not of the "degree of repetition and multiplicity which beclouds definition in a maze of confusion," but, rather, represents the "reasonable latitude in stating [Applicants'] claims in regard to number and phraseology." *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963) (quoted in MPEP § 2173.05(n)). Applicants' conversion of these

dependent claims into independent form clearly lays out the commonality and differences between these claims.

Second, as explained below, the 13 independent claims “differ substantially” from each other.

For example, in the April 2, 2007 Office Action, the Examiner asserted that the common subject matter between present independent claims 1, 3, and 4 (i.e., the subject matter of independent claim 1 at that time) was not patentable, but that the additional subject matter of dependent claims 3 or 4 (now amended to become independent claims 3 and 4) was patentable. Under the Examiner’s own logic, therefore, these differences are substantial, and indeed patentable.

Similarly, in the April 2, 2007 Office Action, the Examiner asserted that the common subject matter between present independent claims 5, 7, 10, and 12 (i.e., the subject matter of independent claim 5 at that time) was not patentable, but that the additional subject matter of dependent claims 7, 10, or 12 (now amended to become independent claims 7, 10, and 12) was patentable. Under the Examiner’s own logic, therefore, these differences are substantial, and indeed patentable.

Similarly, in the April 2, 2007 Office Action, the Examiner asserted that the common subject matter between present independent claims 14, 16, 18, 19, and 20 (i.e., the subject matter of independent claim 14 at that time) was not patentable, but that the additional subject matter of dependent claims 16, 18, 19, or 20 (now amended to become independent claims 16, 18, 19, or 20) was patentable. Under the Examiner’s own logic, therefore, these differences are substantial, and indeed patentable.

Moreover, the text of these independent claims proves that the differences between the subject matter presently recited in these independent claims is substantial:

- “rotation of the wear plate/piercing tip insert between the first and second positions swaps the shearing edges of the two metal tip portions between operative and non-operative positions” (claims 1, 5, and 14);
- “the shearing edge of each tip portion is coplanar with and forms an edge of said generally planar surface” (claim 3);

- “at least one boss or dowel that is located between said metal tip portions and that extends laterally from said central region in the direction of the first side of said body” (claims 4, 10, and 19);
- “the front, nose portion of the movable jaw member has a pocket or cavity extending laterally inwardly from a surface thereof into which the tip portions of the wear plate/piercing tip insert each fit, one of the tip portions being fitted in said pocket or cavity when positioned in a non-operative position” (claim 7) and “the front, nose portion of the jaw body has a pocket or cavity extending laterally inwardly from a surface thereof into which the tip portions of the wear plate/piercing tip insert each fit, one of the tip portions being fitted in said pocket or cavity when positioned in a non-operative position” (claim 16);
- “the front, nose portion of the movable jaw has a depression extending laterally inwardly from a surface thereof that matches surface contours of said at least one boss or dowel, said at least one boss or dowel fitting within said depression” (claim 10) and “the front, nose portion of said jaw member has a depression extending laterally inwardly from a surface thereof that matches surface contours of said boss, said boss fitting within said depression” (claim 19);
- “the blade insert member extends all the way to a forwardmost portion of the front, nose portion of the movable jaw and wherein an inner-facing surface of one of the tip portions that is in an operative position engages with an inner-facing surface of the blade insert” (claim 12);
- “the front, nose portion of the jaw member has a notch formed in an underside thereof, the notch having surface contours that match surface contours of the tip portions; wherein one of the tip portions that is positioned in an operative position engages with said notch” (claim 18); and
- “wherein the cutting/shearing edge is provided by at least one blade insert member” (claim 20)

Overlap between the subject matter of these independent claims is generally due to the Applicants’ separate claiming of an indexable wear plate/piercing tip (claims 1, 3, 4, 42), a metal demolition shears including an indexable wear plate/piercing tip (claims 5, 7, 10, 12), and a jaw

member including an indexable wear plate/piercing tip insert (claims 14, 16, 18, 19, and 20). Applicants submit that their desire to separately claim these three apparati does not unduly multiply the claims.

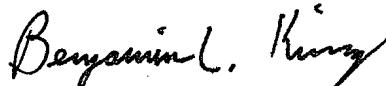
To the extent that the Examiner nonetheless maintains the present multiplicity rejection (limiting Applicants to 5 independent claims and 20 dependent claims), Applicants elect independent claims 1, 5, 7, 14, and 42 and dependent claims 8, 9, 11, 15, 43, 44, 45, 46, 47, 48, 49, 51, 53, 55, 56, and 57 for examination.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is requested.

If the Examiner has any questions or suggestions that will further prosecution of this application, the Examiner is encouraged to contact the undersigned at the below-listed telephone number.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975 under our Order No. 081776-0306363. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,  
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